

BEST AVAILABLE COPY**REMARKS****Overview**

Claims 1-39 were previously pending in the present application. Claims 1-39 were rejected. Claims 28 and 35-39 have been amended. New claim 40 has been added. The present response is an earnest attempt to place the application in proper form for immediate allowance. Reconsideration and passage to issuance is therefore respectfully requested.

It is noted by Applicant that Examiner withdrew previous objections to claims 3 and 35 and rejections to claims 11 and 12. The withdrawal of these objections and rejections is appreciated.

Claim Rejections Under 35 U.S.C. § 103

Claims 1-3, 5-18, 22, 25-30 and 34-38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over D'Alessandro, U.S. Patent No. 6,556,974, in view of Morisawa, U.S. Patent No. 5,537,544.

As discussed with the Examiner in a telephone interview on September 21, 2005, D'Alessandro specifically differentiates itself from one of the Applicant's prior patents, U.S. Patent No. 5,551,880, which is incorporated by reference into the current application, for providing examples of types of surveys or reports that can be presented to respondents as used with the current application. This is given in D'Alessandro, col. 2, lines 13-31, where D'Alessandro states "However, the system ['880 Patent] analyzes the individual employee and not the business entity as a whole." Therefore, D'Alessandro is an improper reference for obviousness because it specifically differentiates itself from systems which analyze the individual employee and not the business entity as a whole, as does the current application. Here all the

claims analyze the individual and not like D'Alessandro, the business entity as a whole. Thus, the rejection based on D'Alessandro should be withdrawn as even the reference itself recognizes this critical difference.

As also discussed with the Examiner, the preamble to independent claim 1 differentiates over D'Alessandro. The preamble to claim 1 states "A method of evaluation or assessment of persons, jobs, or employees comprising" Thus, claim 1 is evaluating individuals and not a business entity as a whole. It is clear from the Federal Circuit case law precedent that every word in a claim must be given meaning. Exxon Chemical Patents, Inc. v. Lubrizol Corp., 64 F.3d 1553, 1557 (Fed. Cir. 1995). Claim limitations defining the subject matter of the invention can never be disregarded. In re Sabatino, 480 F.2d 911, 913 (CCPA 1973). The Patent Office Board of Appeals has explained that in interpreting claims, "The presumption is that every word is meaningful." Id. 480 F.2d at 912.

Thus, the preamble of independent claim 1 for "a method of evaluation or assessment of persons, jobs or employees", is not meaningless but here is a substantial limitation. As explained by the Federal Circuit, "the effect preamble language should be given can be resolved only on review of the entirety of the patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim." Coming Glasswares v. Sumitomo Electric, 868 F.2d 1251, 1257 (Fed. Cir. 1989). In the current application, the specification makes it clear on page 5, last full paragraph, and again on page 8, first full paragraph, which states that:

A report could be one that is designed to gauge an existing employee's aptitude for a present job or for a different job. The report could be one that is designed for an existing employee to evaluate a boss. The report could be one that is designed to evaluate a potential employee's suitability for a particular job. An example of the type of surveys or reports that could be presented to respondents can be found and incorporated U.S. Patent No.

5,551,880. An example of how these surveys can be processed may be found in U.S. Patent No. 5,551,880.

Thus, the specification makes it clear the type of individual assessments intended by the current application and D'Alessandro makes it clear that it intends to assess "the business entity as a whole." The distinction of course is critical. This reference does not even address the same problem. It therefore cannot be seen how it makes the claims *prima facie* obvious alone or in combination with other references.

Additionally, preamble limitations were explained by the Federal Circuit in Eaton Corp. v. Rockwell Int'l Corp., 323 F.2d 1332, 1'339 (Fed. Cir. 2003), wherein the Court stated:

In general, a preamble limits the [claimed] invention if it recites a central structure or steps, or if it is 'necessary to give life, meaning and vitality' to the claims. (citations omitted) [A] claim preamble has the import that the claim as a whole suggest for it. In other words, when the claim drafter chooses to use both the preamble in the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects.

Thus, it is clear that the claim is directed towards an evaluation or assessment of individuals and not business entities as a whole. Since D'Alessandro is specifically directed at evaluating the business entity as a whole, and not individuals, D'Alessandro cannot lead one of ordinary skill in the art to Applicant's claimed invention. In addition, combining Morisawa with D'Alessandro is not taught or suggested. Morisawa discloses a portable computer system having password control means for holding one or more passwords such that the passwords are unreadable by direct access from a main processor. Morisawa is not directed to evaluating businesses or individuals. Therefore, one of ordinary skill in the art would not be directed to combine the two references. Furthermore, no combination of Morisawa and D'Alessandro teach or suggest the limitations as described in the claimed invention even if they were combined. Therefore,

reconsideration and withdrawal of the rejection of claim 1 and allowance is respectfully requested.

Claims 2-27 depend from independent claim 1 and are allowable as depending from an allowable independent claim. Allowance of claims 2-27 is respectfully requested.

As discussed with the Examiner in the interview on September 21, 2005, claim 28 has been amended to specify that the assessment instrument required by the claim is to assess individuals and not business entities as a whole. The Examiner stated that this appeared to be allowable over the cited references, in view of the fact that D'Alessandro specifically differentiates itself from U.S. Patent No. 5,551,880 by assessing business entities and not individuals. Therefore, amended claim 28 is submitted as being allowable. Allowance of claim 28 is respectfully requested.

Claims 29-34 depend from amended claim 28 and are allowable as depending from an allowable claim 28. Allowance of claims 29-34 is respectfully requested.

Similar to claim 28, independent claim 35 has been amended to specify that the assessment survey is to evaluate individuals and not business entities as a whole. Thus, as discussed above for claim 28, amended claim 35 differentiates over D'Alessandro. As a result, amended claim 35 is allowable. Allowance of claim 35 is respectfully requested.

Claims 36-39 have been amended to correct a typographical error from depending from claim 33 to now depending from claim 35. Claims 36-39 depend from allowable claim 35 and are allowable as depending from that claim. Allowance of claims 36-39 is respectfully requested.

New claim 40 has been added to the claims. Claim 40 has the elements of original claim 1 in addition to specifying that the assessment instrument evaluates individuals and not business entities as a whole. This new claim was also indicated as allowable by the Examiner in the

telephone interview of September 21, 2005. Allowance of new claim 40 is respectfully requested.

Certain of the dependent claims have been rejected on the basis of D'Alessandro and Morisawa in combination with other cited references. However, it is respectfully submitted that the remaining dependent claims depend from allowable independent claims and are allowable as depending from allowable claims. Therefore, it is respectfully submitted that these rejections be withdrawn.

Conclusion

It is respectfully submitted that all matters raised in the Office Action of June 27, 2005 have been addressed and remedied and that the application is in form for allowance. A Notice of Allowance for claims 1-40 is respectfully requested.

If for any reason the Examiner feels that this amendment does not so place the application in condition for allowance, it is respectfully requested that the Examiner contact Applicant's attorney by telephone at the number enclosed below so that steps may be taken to place the application in allowable condition.

Please consider this a one-month extension of time from September 27, 2005 to October 27, 2005 and charge Deposit Account No. 26-0084 the amount of \$60.00 for this extension. No other fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any

additional fees to Deposit Account No. 26-0084.

Respectfully submitted,



BART A. FISHER, Reg. No. 55,181
McKee, Voorhees & Sease, P.L.C.
801 Grand Avenue, Suite 3200
Des Moines, Iowa 50309-2721
Phone No. (515) 288-3667
Fax No. (515) 288-1338
CUSTOMER NO: 22885
Attorneys of Record

- bja -

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ **BLACK BORDERS**
- ☐ **IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- ☐ **FADED TEXT OR DRAWING**
- ☐ **BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- ☐ **SKEWED/SLANTED IMAGES**
- ☐ **COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- ☐ **GRAY SCALE DOCUMENTS**
- ☒ **LINES OR MARKS ON ORIGINAL DOCUMENT**
- ☐ **REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- ☐ **OTHER:** _____

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.